| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/720,729 | 12/27/2000 | Masaaki Yamamoto | 9683/74 | 3943 |

757          7590          10/18/2007
BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

| EXAMINER |
|---|
| LY, NGHI H |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2617 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 10/18/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *27 July 2007*.

2a)☒ This action is **FINAL**.     2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *25,33-48 and 83-85* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25,33-48 and 83-85* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☒ All   b)☐ Some * c)☐ None of:

   1.☒ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

*[signature]* 10/14/07
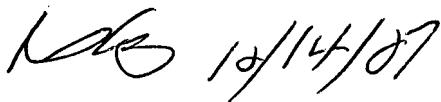
**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

## DETAILED ACTION

### *Response to Amendment*

1.      The Declaration filed on 07/30/07 under 37 CFR 1.131 has been considered but

is ineffective to overcome cited references (Wells et al US 5,870,683, Nishino US

6,233,452 and Thompson et al US 5,809,433).

The evidence submitted is insufficient to establish a conception of the invention

prior to the effective date of the cited references (Wells et al US 5,870,683, Nishino US

6,233,452 and Thompson et al US 5,809,433).  While conception is the mental part of

the inventive act, it must be capable of proof, such as by demonstrative evidence or by

a complete disclosure to another.  Conception is more than a vague idea of how to

solve a problem.  The requisite means themselves and their interaction must also be

comprehended.  See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir.

1897).  Wells et al (US 5,870,683), Nishino (US 6,233,452) and Thompson et al (US

5,809,433) were filed before the filing date of the present application (dated

05/14/1999).

The evidence submitted is insufficient to establish diligence from a date prior to

the date of reduction to practice of the cited reference (Wells et al US 5,870,683,

Nishino US 6,233,452 and Thompson et al US 5,809,433) to either a constructive

reduction to practice or an actual reduction to practice.  The filing dates of cited

references (Wells et al US 5,870,683, Nishino US 6,233,452 and Thompson et al US

5,809,433) prior to the filing date of applicant (dated 05/14/1999).

### *Response to Arguments*

2.      Applicant's arguments filed 07/27/07 have been fully considered but they are not

persuasive.

On page 6 of applicant's remarks, applicant argues that Wells and Nishimo,

either alone or combined, do not disclose or teach all of the limitations recited in the

pending claims.

In response, the combination of Wells and Nishimo does indeed teach all of the

limitations recited in the pending claims.   In addition, applicant's attention is directed to

the teaching of Wells and Nishimo below.

On pages 9 and 10 of applicant's remarks, applicant argues that there is nothing

in Wells that discloses or teaches the registration control.

In response, Wells does indeed teach "registration control" (see column 10, lines

33-39 and column 14, lines 1-43, see "a controller" and it reads on applicant's "the

registration control". In addition, applicant's specification fails to further define what "the

registration control" is.  Therefore, the teaching of Wells does indeed teach applicant's

claimed limitations using the broadest reasonable interpretation.

On page 10 of applicant's remarks, applicant argues that Wells, even if combined

with Nishino, still fails to teach claim 15.

In response, claim 15 has been cancelled.

On page 10 of applicant's remarks, applicant further argues that Nishino does not

disclose or teach the registration control recited in claim 25, there is nothing in Nishino

that discloses or teaches how data downloaded from the Internet can be selectively

registered. Since neither Wells nor Nishino discloses or teaches the registration control

recited in claim 25, Wells and Nishino even if combined still fail to disclose all of the

limitations of claim 25.

In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., *data downloaded from the Internet can be selectively registered*) are not recited in

the rejected claim(s).  Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims.  See *In re Van Geuns*, 988

F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993), and

in response to applicant's arguments against the references individually, one

cannot show nonobviousness by attacking references individually where the rejections

are based on combinations of references.  See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

1986).  In this case, Well teaches the registration control recited in claim 25.  In addition,

applicant's specification fails to further define what "the registration control" is.

Therefore, the teaching of Wells does indeed teach applicant's claimed limitations using

the broadest reasonable interpretation, and the combination of Wells and Nishino does

indeed teach claim 25.

## *Claim Rejections - 35 USC § 103*

3.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.    This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

5.    Claims 25, 33, 34, 38, 39, 41-48, 84 and 85 are rejected under 35 U.S.C. 103(a)

as being unpatentable over Wells et al (US 5,870,683) in view of Nishino (US

6,233,452).

Regarding claim 25, Wells teaches a mobile communication terminal that

receives communications services from a mobile wireless network (see fig.2, RF

connection between a mobile communication terminal 10 and a mobile wireless network

32. In addition, see column 3, lines 2-5, see "*Internetworking*"), comprising: a

communication control that selectively implements multiple communication

functionalities comprising a voice communication functionality (column 3, lines 8-14, see

"speech"), an electronic message communication functionality (column 10, lines 9-25,

see "Short Message Service (SMS) message") and a network functionality (column 10,

lines 9-25, see "can be loaded from the network 32"), wherein while implementing the

multiple communication functionalities, at least one standby state is realizable in which

no user action is prompted (Abstract and column 2, lines 13-25, see "Idle state"), a

viewer that activates the network functionality to selectively access information provider

servers located in the second network (column 10, lines 9-25, see "can be loaded from

the network 32" and see column 3, lines 2-5, see "*Internetworking*" and "*a connection to*

*land line trunks*" and they read on applicant's "*the second network*") and receive <u>one</u> or

more blocks of screen data (Abstract and column 2, lines 13-25, see "Idle state" and

"<u>selectively display</u>" and "displayed during an Idle state", and see column 3, line 54 to

column 4, line 10 and see fig.3A to fig.4C.  In addition, see column 4, lines 47-53, see

"<u>be erased and replaced with the same or different characters</u>") from the accessed

information provider server for preview of the received one or more blocks of screen

data by a user of the mobile communication terminal (column 10, lines 9-25, see "can

be loaded from the network 32".  In addition, applicant's specification fails to disclose or

define the newly added "preview"), a registration control upon a selection by the user of

one block of screen data through the preview of the received one or more blocks of

screen data, stores the selected one block of screen data in one of multiple memory

areas each correlatable to any one of the at least one standby state (see column 4,

lines 11-16 and see column 8, lines 9-13, and see Abstract and column 2, lines 13-25,

see "Idle state" and "<u>selectively display</u>" and "displayed during an Idle state", see

column 10, lines 33-39 and column 14, lines 1-43, see "a controller" and it reads on

applicant's "the registration control".  In addition, applicant's specification fails to further

define what "the registration control" is. Therefore, the teaching of Wells does indeed

teach applicant's claimed limitations using the broadest reasonable interpretation), a

correlation control responsive to an instruction from the user to <u>dynamically</u> correlates

the one of the multiple memory areas to a selected one of the at least one standby state

selected by the user (see column 2, lines 12-25, see "<u>selectively</u> display" and column 8,

lines 9-13, see "user choice", and see column 5, lines 39-45, see "if a <u>user selects</u> an

animation". Wells teaches "<u>selectively</u> display" and "if a <u>user selects</u> an animation" and

they read on Applicant's "<u>dynamically</u> correlates"), and a display control that, when the

terminal is in the selected one of the at least one standby state, displays the selected

one of the one or more blocks of screen data (Abstract and column 2, lines 13-25, see

"Idle state" and "<u>selectively display</u>" and "displayed during an Idle state" and see column

5, lines 39-45, see "if a <u>user selects</u> an animation" or see column 8, lines 14-15, see

"select<u>ed</u> animation").

Wells does not specifically disclose a network browsing functionality for browsing

a second network located outside the mobile wireless network and the viewer that

activates the network browsing functionality access information provider servers located

in the second network.

Nishino teaches disclose a network browsing functionality for browsing a second

network located outside the mobile wireless network and the viewer that activates the

network browsing functionality access information provider servers located in the

second network (see Abstract and column 13, line 65 to column 14, line 5, see

"browsing", "Web page" and "Internet". Nishino's "*Internet*" reads on applicant's "*a second network located outside the mobile wireless network*").

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Nishino into the system of Wells so that the terminal is allowed to download an electronic destined therefor (see Nishino, Abstract).

Regarding claim 33, Wells further teaches the registration control determines, based on one or more attributes attached to the selected one of the one or more of the received screen data, whether the selected block of the received screen data is storable (see column 3, line 54 to column 4, line 10, and column 4, lines 11-14).

Regarding claim 34, Wells further teaches one of the attributes is a size of the selected block of the received screen data (see column 3, line 54 to column 4, line 10).

Regarding claim 38, Wells teaches one of the attributes is a communication protocol adopted in the network (see column 10, lines 9-25, the teaching of Wells inherently teaches Applicant's "one of the attributes is a communication protocol adopted in the network").

Regarding claim 39, Wells teaches different screen data is selectively displayed in a standby state (Abstract and column 2, lines 13-25, see "Idle state" and "selectively display" and "displayed during an Idle state" and see column 5, lines 39-45, see "if a user selects an animation" or see column 8, lines 14-15, see "selected animation").

Regarding claim 41, Wells teaches different screen data is displayed in a standby state in a periodic rotation (column 4, lines 1-4, see "displayed sequentially").

Regarding claim 42, Wells further teaches one of the at least one standby state
is a standby state in which the terminal is waiting for a call to come in or for the user to
key in (see Abstract).

Regarding claim 43, Wells further teaches one of the at least one standby state is
a state of downloading data from the data source (see Abstract and column 10, lines
10-25).

Regarding claim 44, Wells further teaches the display control keeps displaying
screen data until an occurrence of an event triggers a shift from the standby state (see
column 2, lines 12-33).

Regarding claim 45, Wells further teaches the selected one of the one or more of
the screen data is processed for display (see column 3, line 54 to column 4, line 10).

Regarding claim 46, Wells further teaches the size of the image represented by
the selected one of the one or more of the screen data is adjusted (see column 10, lines
21-24).

Regarding claim 47, Wells further teaches the image represented by the selected
one of the one or more of the screen data is repeated (column 4, lines 1-4, see
"displayed sequentially").

Regarding claim 48, Wells further teaches the image represented by the selected
one of the one or more of the screen data is placed at a designated location on a
display of the terminal (see fig.3A and 3B).

Regarding claim 84, Wells and/or Nishino further teaches the second network is an Internet (see Wells, column 3, lines 2-5, see "*Internetworking*" or see Nishino, Abstract).

Regarding claim 85, Wells and/or Nishino further teaches the one or more blocks of screen data are received from a web page on the Internet (see Wells, column 3, lines 2-5, see "*Internetworking*" or see Nishino, Abstract).

6.      Claims 35, 36, 37 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wells et al (US 5,870,683) in view of Nishino (US 6,233,452) and further in view of Official notice.

Regarding claims 35, 36, 37 and 40, the combination of Wells and Nishino teaches claim 25. The combination of Wells and Nishino does not specifically disclose the attributes is copyright protection *or* one of the attributes is identification of a network through which the screen data was downloaded received one of the attributes is an encryption method with which the screen data is encrypted *or* different screen data is randomly displayed in a standby state. However, the examiner takes Official notice that such feature as recited is very well known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination as claimed in order to improve one of the attributes is copyright protection *or* one of the attributes is identification of a network through which the screen data was downloaded received one

of the attributes is an encryption method with which the screen data is encrypted *or*

different screen data is randomly displayed in a standby state.


7.      Claim 83 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wells et

al (US 5,870,683) in view of Nishino (US 6,233,452) and further in view of Thompson et

al (US 5,809,433).

Regarding claim 83, the combination of Wells and Nishino teaches claim 25. The

combination of Wells and Nishino does not specifically disclose one of the at least one

standby state is a state of receiving an e-mail.

Thompson teaches one of the at least one standby state is a state of receiving an

e-mail (see column 1, lines 45-48).

Therefore, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to provide the teaching of Thompson into the system of

Wells and Nishino so that during the standby mode, the radio telephone can receive

electronic mail.


### Conclusion

8.      **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (571) 272-7911. The examiner can normally be reached on 9:30am-8:00pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on (571) 272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nghi H. Ly